



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/374,577	08/13/1999	FORREST NABORS	34533-51	3935

7590

07/09/2003

ATTN: GREGORY D. CALDWELL
BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP
12400 WILSHIRE BOULEVARD
7TH FLOOR
LOS ANGELES, CA 90025

EXAMINER

CHOULES, JACK M

ART UNIT

PAPER NUMBER

2177

DATE MAILED: 07/09/2003

16

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/374,577

Applicant(s)

NABORS ET AL.

Examiner

Jack M Choules

Art Unit

2177

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 September 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-66,69 and 70 is/are pending in the application.
- 4a) Of the above claim(s) 1-47 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-66,69 and 70 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-47 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 August 1999 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

1. Claims 1-66, 69-70 are presented for examination. Claims 1-47 having been withdrawn from consideration.

Response to Arguments

1. Applicant's arguments filed May 30, 2003 have been fully considered but they are not persuasive.
2. Applicant's arguments with respect to the 103 rejections of claims 1-66, 69-70 have been considered but are moot in view of the new ground(s) of rejection.
3. The Applicant argues that the claim 58 being drawn to a propagated signal, which is clearly statutory subject matter.
4. In response the examiner respectfully argues that the current office position is that a propagated signal is clearly not statutory unless propagated on a carrier wave.

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 58-68 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims are apparently directed to a Data structure Per se as it is not clearly claimed as embodied in a computer readable media or a signal on a carrier wave.

See Warmerdam, 33 F.3d at 1360-1361 (claim to computer having specific memory held statutory, claim to data structure per se held non-statutory).

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. **Claims 48-66 and 69-70 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rothrock, US Patent Number 5,748,618 in view of Draft Proposal [hereinafter the draft] "An Industry Standard Data Format for the Export and Import of Automotive Customer Leads"** (Note: the draft was provided by the applicant in a IDS provided 13 March 2000 further although the art does not predate CIP priority application number 09/188,863 the subject matter of the claims is not found in that application.)

Art Unit: 2177

5. As to claims 48, 58, 69 and 70 the Rothrock disclosed the invention substantially as claimed including a data processing system ['DP'] comprising a hierarchical data structure (figure 3); "a public block" (figure 3, index 310), "a private block" (figure 3, index 302) and the general principle of and blocks sub-blocks and categories and data items (figure 3). delimiters (page 6-14); (page 6-14).

6. The draft does not detail delimiters and the specific blocks sub-blocks and categories and data items claimed. The draft describes delimiters (page 6-14); and the specific blocks sub-blocks and categories and data items claimed (page 6-14). No attempted has been made to match the actual contents of the blocks, sub-blocks, categories data elements for example "manufacture, model, model year and style of the vehicle as this is all non-functional descriptive material and any difference in this rearrangement or non- functional descriptive material and considered well within the capabilities of one of skill in the art to implement Cf. In re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983 (when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability)).

7. It would have been obvious to one of ordinary skill in the DP art at the time of the applicant's invention to combine the teachings of the draft with Rothrock because the draft includes personal data (draft page 3) and it would have been obvious to protect this data from public distribution to protect the interests of the client in the system also the draft shows the particular the need to set up databases directed to the automotive area was known and accepted and the necessary elements to include in such a database.

Art Unit: 2177

8. As to claims 49, 50, 59, and 60, in the draft delimiters for the sub-blocks etc are considered to indicate block or sub-block they belong to by positioning (page 6-14) further linking the delimiters to the hierarchical element they depend on is considered obvious to maintain the hierarchal structure.

9. As to claims 51-55 and 61-65 these claims detail non-functional descriptive material and thus do not distinguish over the prior art (see explanation to rejection of claim 48 hereinabove).

10. As to claims 56-66, the draft details XML (page 3).

11. Claims 48-66 and 69-70 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rothrock, US Patent Number 5,748,618 in view of Kozol et al. [hereinafter the Kozol] "An Industry Standard Data Format for the Export and Import of Automotive Customer Leads"

12. As to claims 48, 58, 69 and 70 the Rothrock disclosed the invention substantially as claimed including a data processing system ['DP'] comprising a hierarchical data structure (figure 3); "a public block" (figure 3, index 310), "a private block" (figure 3, index 302) and the general principle of and blocks sub-blocks and categories and data items (figure 3). delimiters (page 6-14); (page 6-14).

13. Rothrock does not detail delimiters and the specific blocks sub-blocks and categories and data items claimed. Kozol delimiters (figure 1); and blocks sub-blocks and categories and data items (figure 1).). No attempted has been made to match the actual contents of the blocks, sub-blocks, categories data elements for example "manufacture, model, model year and style of the vehicle as this is all non-functional descriptive material and any difference in this rearrangement

Art Unit: 2177

or non- functional descriptive material and considered well within the capabilities of one of skill in the art to implement Cf. In re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983 (when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability)).

14. It would have been obvious to one of ordinary skill in the DP art at the time of the applicant's invention to combine the teachings of Kozol with Rothrock because the draft includes personal data (draft page 3) and it would have been obvious to protect this data from public distribution to protect the interests of the client in the system also Kozol shows the particular the need to set up databases directed to the automotive area was known and accepted and the necessary elements to include in such a database.

15. As to claims 49 and 50, the delimiters for the sub-blocks etc are considered to indicate block or sub-block they belong to by positioning (figure 1) further linking the delimiters to the hierarchical element they depend on is considered obvious to maintain the hierarchal structure.

16. As to claims 51-55 and 61-65 these claims detail non-functional descriptive material and thus do not distinguish over the prior art (see explanation to rejection of claim 48 hereinabove).

17. As to claims 56 and 66, Kozol details SGML (abstract) XML is a standard derived from SGML so it would be obvious to also use the features of the Kozol invention with XML, as it would extend to the functionality to the new standard.

Conclusion

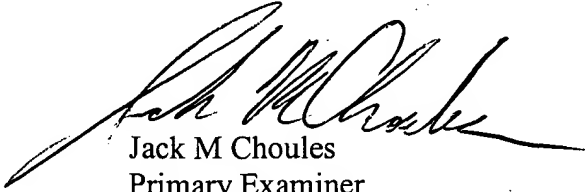
5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- | | | | |
|----|----------------|-----------|--|
| a. | Bsaibes et al. | 5,701,458 | Access control lists hierarchal system |
| b. | Messina | 5,471,619 | Access control system. |

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jack M Choules whose telephone number is (703) 305-9840. The examiner can normally be reached on M-F (7:30-4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John E. Breene can be reached on (703) 305-9790. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-7239 for regular communications and (703) 746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.


Jack M Choules
Primary Examiner
Art Unit 2177